R E M A R K S

Prior to entry of this Amendment:

- Claims **1 – 44 and 55** were pending in the present application.

Upon entry of this Amendment, which is respectfully requested for the reasons set forth below:

- Claims **1- 6, 21 – 26, 35 – 40, 55 and 56** will be pending;
- Claims **7 – 20, 27 – 34, 41 - 54** will be canceled; and
- Claim **56** will be added.

1. Section 102 Rejection over Raven

Claims **1 – 34 and 44** stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,429,361 to Raven et al. ("Raven" herein).

Of these rejected claims, claims **7 – 20, 27 – 34 and 44** have been cancelled without prejudice or disclaimer. Accordingly, the rejection of these claims is not addressed herein.

Of the remaining rejected claims, only claim **1 and 21** are independent. Applicants have amended each of claims **1 and 21** to recite the following features, which are not taught or suggested by Raven:

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- *determining a feature of a game machine, the feature being selected based on the gaming activity,*

  wherein the feature comprises a feature that may be activated based on a selection by the player; and

- *outputting the message to the player via the game machine, the message comprising a recommendation of the feature*

Raven does not teach or suggest recommending a feature of a game machine to a player at all, much less doing so where the feature is selected based on gaming activity of the player (or associated with the player) to whom the message is output. Raven certainly does not teach or suggest recommending a feature in such a manner wherein the feature comprises a feature that may be activated based on a selection by the player.

Applicants note that the Examiner has asserted that Raven discloses "recommendation of a feature on the game machine", with respect to now cancelled claim 7. The Examiner has asserted that Raven discloses this at "Abstract, Figure 2, Column 2, line 66 – Column 3, line 16, Column 5, line 15 – Column 6, line 6, Column 8, lines 40 – 67, Column 9, lines 35 – 50, Column 11, lines 15 – 23, and Claims 1, 4 and 5." Current Office Action, page 4. Applicants respectfully traverse this assertion. Applicants have reviewed each of these passages of Raven and have been unable to find any suggestion of a message that includes a recommendation of a feature on the game machine. Irrespective of this fact, as noted above, independent claims **1 and 21**, and all claims dependent therefrom, are patentable over Raven at least because Raven does not teach or suggest the features discussed above that are now recited in these claims (e.g.,

outputting a message that comprises a recommendation of a feature of the game machine, wherein the feature is selected based on gaming activity).

It is worth noting that the term "feature" has been defined by Applicants in the Specification, at page 13, lines 19 – 23.

2. Section 102 Rejection over Beaulieu et al.

Claims **35 – 43 and 55** stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pub. No. 2003/0064782 to Beaulieu et al. ("Beaulieu" herein).

Of these rejected claims, claims **41 – 43** have been cancelled herein without prejudice or disclaimer. Accordingly, Applicants do not discuss the rejection of these claims herein.

Of these rejected claims, only claims **35 – 40 and 55** will remain pending upon entry of this amendment. Applicants respectfully traverse the 102(e) rejection of these claims on the grounds that (i) Beaulieu does not disclose all of the elements of any single claim, and (ii) no prima facie case of anticipation has been established because it has not been shown that Beaulieu discloses all of the elements of any single claim. For purposes of brevity, the discussion below is limited to the independent claims.

Claim 35

Independent claim **35** recites the following feature that is not taught or suggested by Beaulieu:

- *Outputting the representation of the message to a player at a gaming machine, wherein determining a representation includes selecting a representation from a plurality of representations*

The Examiner has asserted that the above feature is disclosed by <u>Beaulieu</u> at "Abstract, Figures 4 – 15, Paragraphs 5, 8 – 10, 50, 52 – 54, 60, and Claims 1 – 24." Current Office Action, page 13. Applicants respectfully disagree that any of these passages disclose *selecting a representation from a plurality of representations*.

A representation has been defined in the specification as "a method of outputting a message and/or a format in which a message is presented. For example, a message may have a plurality of message representations (*e.g.*, one in English, one in Spanish, one in green, one in yellow, one in audio, *etc.*)." Specification, page 16, lines 8 – 11. In other words, a representation of a message is distinct from the message itself. Thus, selecting a representation of a message from a plurality of representations should not be confused with selecting a message from a plurality of messages (a distinct concept of the present invention).

At most, <u>Beaulieu</u> describes that (i) a message may, in different embodiments, be output in different manners and (ii) that different messages may be output via different manners.

As an example of (i), in paragraph 0009 Beaulieu describes that in the preferred embodiment a message is output by appearing "from behind the functional game element when the functional game element is in play...In an alternative embodiment, the message is displayed on the functional game element." In other words, an entity implementing the <u>Beaulieu</u> system may elect to implement either the embodiment in which messages appear from behind the functional game element or the embodiment in which messages appear on the functional game element. However, such an implementation choice of two different methods in no way anticipates a method of the present invention in which

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a representation for a determined message is *selected from a plurality of representations*. In other words, in the embodiment of claim **35** a plurality of representations is available for selection. <u>Beaulieu</u> does not enable how a representation for a particular message could or would be *selected from a plurality of representations*.

As an example of (ii), Figs. 12 – 15 illustrate two messages, each message being output in what appears to be a different representation (e.g., one appears to be output as a text representation, one as a graphical representation). In other words, <u>Beaulieu</u> at most discloses outputting a first message in a first representation and outputting a second message in a second representation. See, for example, the description of Figs. 12 – 15, at paragraphs 0060 through 0062, in which an animated message and a secondary message are described. However, outputting a first message in a first representation and outputting a secondary message via a second representation in no way anticipates or renders obvious *selecting* for a particular message *a representation from a plurality of representations*.

In summary, there is no hint or disclosure of a method in which *a representation* of a particular message is *selected from a plurality of representations*. In fact, <u>Beaulieu</u> is completely devoid of any discussion of how a message may be selected or how any aspect (much less a representation) of a message may be selected from a plurality of choices. Not only does <u>Beaulieu</u> not *describe* that a method in which a representation for a message is selected from a plurality of representations, <u>Beaulieu</u> does not *enable* any manner of *selecting a representation* of the message from a plurality of representations. Thus, <u>Beaulieu</u> necessarily does not enable a method in which *a representation* for a determined message *is selected from a plurality of representations*.

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<u>Claim 36</u>

Claim **36** recites the following set of features that is not taught or suggested by <u>Beaulieu</u>:

- *determining a first representation of the message and a second representation of the message;*
- *outputting the first representation of the message to a first player at a game machine; and*
- *outputting the second representation of the message to a second player at a game machine*

<u>Beaulieu</u> is completely devoid of any hint that more than one representation may be determined for the same message (as discussed in detail with respect to claim **35**, above). Further, <u>Beaulieu</u> certainly does not disclose, much less enable, outputting different representations of the same message to different players. Applicants have reviewed each of the passages cited by the Examiner (Current Office Action, page 13) as allegedly disclosing this feature but have been unable to find any hint in any of the passages of *outputting a first representation of a message to a first player and outputting the second representation of the message to a second player*. In fact, <u>Beaulieu</u> is completely devoid of any hint of differentiating among different players in any respect, much less of providing different representations of the same message to different players. In <u>Beaulieu</u>, once an entity chooses to implement a particular manner of outputting a message (e.g., "on the functional game element"), there is nothing in <u>Beaulieu</u> that even suggests that the message is not output to all players via the same chosen manner.

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Further, <u>Beaulieu</u> does not disclose or suggest the following additional set of features recited in claim **36**:

- *wherein determining the first representation includes selecting a representation based upon a characteristic of the first player, and*
- *wherein determining the second representation includes selecting a representation based upon a characteristic of the second player*

Applicants have reviewed the entirety of <u>Beaulieu</u> and, based upon this review, respectfully submit that <u>Beaulieu</u> does not describe selecting anything based upon a characteristic of a player, much less selecting a representation of a message based upon a characteristic of a player.

If the Examiner maintains the 102 rejection of claim **36** over <u>Beaulieu</u>, Applicants respectfully request that Examiner provides a more detailed explanation of which portions of <u>Beaulieu</u> the Examiner is interpreting as disclosing the features of claim **36**.

Claim 38

Claim **38** recites the following set of features that is not taught or suggested by <u>Beaulieu</u>:

- *determining a first representation of the message and a second representation of the message;*
- *outputting the first representation of the message to a first player at a game machine; and*

- *outputting the second representation of the message to a second player at a game machine*

As discussed with respect to claim **36**, above, not only is <u>Beaulieu</u> completely devoid of any hint that more than one representation may be determined for the same message, <u>Beaulieu</u> certainly does not disclose, much less enable, outputting different representations of the same message to different players.

Further, <u>Beaulieu</u> does not teach or disclose the following additional set of features that is recited in claim **38**:

- *wherein determining the first representation includes selecting a representation based upon an indication by the first player, and*
- *wherein determining the second representation includes selecting a representation based upon an indication by the second player*

As discussed above with respect to claim **35**, <u>Beaulieu</u> does not disclose any method that includes selecting a representation of a message. <u>Beaulieu</u> certainly does not disclose selecting a representation of a message based upon an indication by a player, much less any method in which a first representation for a particular message is selected based upon an indication by one player while a second representation of the message is selected based upon an indication by another player.

At most, <u>Beaulieu</u> may be interpreted to suggest that a message may be output based upon an indication of a player. For example, <u>Beaulieu</u> discloses that

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an animated message may appear when a functional game element is in play and a player may cause a functional game element to be in play (e.g., paragraph 0009). However, outputting a message is a distinct concept from selecting a representation of a message, as discussed above. Any disclosure of outputting a message in no way anticipates or enables a method of selecting a representation of a message.

Claim 40

Claim **40** recites the following set of features that is not taught or suggested by Beaulieu:

- *suppressing output of the message [that has been determined for output to a player],*

  wherein suppressing output of the message

  includes delaying output of the message until a trigger

  condition is satisfied

Beaulieu does not disclose *suppressing output of a message* in any manner, much less *until a trigger condition is satisfied*. Beaulieu describes an animated message being output each time a functional game element is in play and does not even hint that the animated message may be suppressed under any circumstances.

Claim 55

Claim **55** recites the following set of features that is not taught or suggested by Beaulieu:

- *identifying a message in a database of messages based on the trigger condition;*

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- *suppressing output of the message until a second trigger condition is satisfied*

Beaulieu discloses outputting an animated message when a functional game element is in play. Thus, at most, Beaulieu discloses outputting a message when a condition is satisfied. Beaulieu is completely devoid of any suggestion of identifying a message based on a first condition and then suppressing the message until a second condition is satisfied. In fact, Beaulieu is completely devoid of any disclosure of more than one condition being relevant to the output of a single message, much less that one condition is relevant to identifying the message while a second condition is relevant to ending suppression of the message.
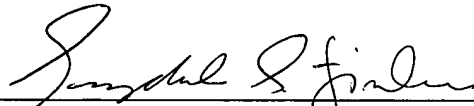
Conclusion

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

Please charge any fees that may be required for this Amendment to <u>Deposit Account No. 50-0271</u>. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to <u>Deposit Account No. 50-0271</u>.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number (203) 461 – 7041 or via electronic mail at mfincham@walkerdigital.com.

Respectfully submitted,

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Date

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